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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/467,405 12/20/99 ENGEL

D 758.556USC4

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IM62/0719

EXAMINER

BUSHEY, C

ART UNIT

PAPER NUMBER

1724

DATE MAILED:

7
07/19/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/467,405

Applicant(s)

ENGEL ET AL

Examiner

Scott Bushey

Group Art Unit

1724



☒ Responsive to communication(s) filed on Jun 23, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 17-27 and 34-39 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 17-27 and 34-39 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 2 sheets

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 1724

DETAILED ACTION

1. Applicant's election without traverse of Group II, original claims 17-27, and newly added claims 34-39 in Paper No. 6 is acknowledged.
2. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).
3. Claim 25 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 25, line 2, --cap-- should be inserted after "end".

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

(f) he did not himself invent the subject matter sought to be patented.

(g) before the applicant's invention thereof the invention was made in this country by another who had not abandoned, suppressed, or concealed it. In determining priority of invention there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other.

Art Unit: 1724

5. Claims 17-24, 26, 27, and 34-39 are rejected under 35 U.S.C. 102(e) as being anticipated by Engel '992.

The applied reference has a common inventor and assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.130 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another".

For applicant's convenience the following section from the MPEP has been reproduced:

§ 1.130 Affidavit or declaration to disqualify commonly owned patent as prior art.

(a) When any claim of an application or a patent under reexamination is rejected under 35 U.S.C. 103 in view of a U.S. patent which is not prior art under 35 U.S.C. 102(b), and the inventions defined by the claims in the application or patent under reexamination and by the claims in the patent are not identical but are not patentably distinct, and the inventions are owned by the same party, the applicant or owner of the patent under reexamination may disqualify the patent as prior art. The patent can be disqualified as prior art by submission of:

- (1) A terminal disclaimer in accordance with § 1.321(c), and
- (2) An oath or declaration stating that the application or patent under reexamination and the patent are currently owned by the same party, and that the inventor named in the application or patent under reexamination is the prior inventor under 35 U.S.C. 104.

Art Unit: 1724

(b) When an application or a patent under reexamination claims an invention which is not patentably distinct from an invention claimed in a commonly owned patent with the same or a different inventive entity, a double patenting rejection will be made in the application or a patent under reexamination. A judicially created double patenting rejection may be obviated by filing a terminal disclaimer in accordance with § 1.321(c). [Added, 61 FR 42790, Aug. 19, 1996, effective Sept. 23, 1996]

37 CFR 1.130(a) has been added to provide for those situations in which: (1) the rejection in an application or patent under reexamination to be overcome is a rejection under 35 U.S.C. 103 in view of a U.S. patent which is not prior art under 35 U.S.C. 102(b); (2) the inventions defined by the claims in the application or patent under reexamination and by the claims in the U.S. patent are not identical but are not patentably distinct; and (3) the inventions are owned by the same party. An applicant or owner of a patent under reexamination in this situation is prevented from using 37 CFR 1.131 to antedate a commonly owned U.S. patent due to the requirement in 37 CFR 1.131 that any U.S. patent to be antedated not claim the same patentable invention (as defined in 37 CFR 1.601(n)) as the application or patent under reexamination, and is prevented from proceeding in an interference due to the provision in 37 CFR 1.602(a) that an interference will not be declared or continued between an application and an unexpired patent owned by a single party.

As 37 CFR 1.130(a) was added for those situations in which the inventions defined by the claims in the application or patent under reexamination and by the claims in the U.S. patent are

Art Unit: 1724

not patentably distinct, 37 CFR 1.130(a)(1) requires a terminal disclaimer in accordance with 37 CFR 1.321© and 37 CFR 1.130(a)(2) requires an oath or declaration stating, inter alia , that the inventor named in the application or patent under reexamination is the prior inventor under 35 U.S.C. 104. The inventor named in the application or patent under reexamination must have invented the claimed subject matter before the actual date of invention of the subject matter of the reference U.S. patent claims. The oath or declaration may be signed by the inventor(s), the attorney of record, or assignee(s) of the entire interest.

The phrase "prior inventor under 35 U.S.C. 104" requires that the inventor named in the application or patent be the prior inventor within the meaning of 35 U.S.C. 104, in that an applicant or patent owner may not: (1) establish a date of invention in a foreign country other than a NAFTA or WTO member country; (2) establish a date of invention in a WTO member country other than a NAFTA country earlier than January 1, 1996; or (3) establish a date of invention in a NAFTA country other than the U.S. earlier than December 8, 1993.

As the conflict between two pending applications can be avoided by filing a continuation - in - part application merging the conflicting inventions into a single application, 37 CFR 1.130 is limited to overcoming rejections under 35 U.S.C. 103 based on commonly owned U.S. patents.

37 CFR 1.130(b) provides that when an application or a patent under reexamination claims an invention which is not patentably distinct from an invention claimed in a commonly owned patent with the same or a different inventive entity, a double patenting rejection will be made in the application or a patent under reexamination. A judicially created double patenting

Art Unit: 1724

rejection may be obviated by filing a terminal disclaimer in accordance with 37 CFR 1.321(c). See MPEP § 804.02.<

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 102(e), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered in the instant application were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 102(e) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 17-24, 26, 27, and 34-39 are rejected under 35 U.S.C. 102(f) or (g) because the applicant did not invent the claimed subject matter. As stated above the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered in the instant application were made absent any evidence to the contrary. Consequently, claims 17-24, 26, 27, and 34-39 have been presumed as commonly owned by all of the inventors named in the instant application, which would conflict with the fact that Engel '992, which names only a single inventor, includes disclosure that clearly anticipates the invention as recited by instant claims 17-24, 26, 27, and 34-39.

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686

Art Unit: 1724

F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 17-27, 34-36, 38, and 39 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 3, 4, and 9-11 of U.S. Patent No. 6,004,366. Although the conflicting claims are not identical, they are not patentably distinct from each other because patent claims 1, 3, 4, and 9-11 of U.S. Patent No. 6,004,366 recite a filter element with first and second opposite end caps, the first end cap having an air inlet opening, and the second end cap having a central drainage aperture and an interior surface to direct moisture to the central drainage aperture, as recited by instant claims 17-27, 34-36, 38, and 39.

10. Claim 37 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 5,613,992. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 1 of U.S. Patent No. 5,613,992 recites a filter element with first and second opposite end caps, the first end cap having an air inlet opening, and the second end cap having a central drainage aperture and an interior surface to direct moisture to the central aperture, the second end cap comprising sheet metal.


Art Unit: 1724

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott Bushey whose telephone number is (703) 308-3581.

csb

July 18, 2000

C. SCOTT BUSHEY
PRIMARY EXAMINER
GROUP 1300


7-18-00